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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/629,709 | 07/30/2003 | Hitoshi Watanabe | 00862 023164 | 5361 |
| 5514 7590 04/30/2008 FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112 | | | | |
| EXAMINER PHAM, THIERRY L | | | | |
| ART UNIT 2625 | | PAPER NUMBER | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/629,709

Applicant(s)

WATANABE, HITOSHI

Examiner

THIERRY L. PHAM

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

- This action is responsive to the following communication: RCE filed on 4/15/08.
- Claims 1-6 are currently pending.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/15/08 has been entered.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 rejected under 35 U.S.C. 102(b) as being anticipated by Bigi (US 20020085223).

Regarding claim 1, Bigi discloses an input apparatus (host computer 150, fig. 1) which is capable of directly transmitting a digital image to an image output apparatus (printer 180, fig. 1), comprising:

- an obtaining unit (printer driver obtains printer's properties via "properties icon 310", fig. 3, par. 49-52) configured to obtain from the image output apparatus, capability information (capability information as shown in fig. 4a-4b, par. 52) including information related to an image outputting function (figs. 4a-4b, par. 52) of the image output apparatus;
- a user interface selector (user interface as shown in figs. 4a-4b) that selects, based on the capability information obtained by said obtaining unit, a user interface (plurality of different user

interface for controlling the printer, figs. 4a-4b) for controlling the image output apparatus (each interface enables user to select features/attributes to control the printer, fig. 4a-4b); and

- a display unit configured to display (monitor 150a, fig. 1) the user interface selected by said user interface selector

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 2-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bigi as described in claim 1 above, and further in view of Aguilera et al (US 20030043204).

Regarding claims 2-5, Bigi fails to teach and/or suggest a user interface of a printer driver that enables users/operators to disable the trimming function.

Aguilera, in the same field of endeavor for printing, teaches a user interface of a printer driver that enables users/operators to disable the trimming function (fig. 3 shows a user interface with trimming function, wherein a trimming function is disabled when the oval box is unchecked).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify printer driver of Bigi to include a user interface that allows users/operators to disable the trimming function (e.g. via not checking the trimming oval box) as taught by Aguilera. Aguilera also teaches a selector (fig. 3) selects a user interface that does not include an item related to the trimming image output function (interfaces such as fold, staple, and copy in color are not related to the trimming function and are separated from each other, fig. 3). The motivation for doing so would have been that if the user does not want trimming operation of the image to be printed, he and/or she can disable it from happening by not checking/selecting the

trimming oval box (fig. 3 of Aquilera) or if the printer does not support trimming capability, then he/she can disable it by not checking/selecting the trimming oval box (fig. 3).

Therefore, it would have been obvious to combine Bigi with Aguilera to obtain the invention as specified in claim 1.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bigi as described in claim 1 above, and further in view of Parulski et al (US 20070139526).

Regarding claim 6, Bigi fails to teach and/or suggest wherein said image input apparatus is a digital camera.

Parulski, in the same field of endeavor for acquiring printer's capability, teaches a well-known example of wherein an image input apparatus is a digital camera (camera 10 obtains printer's capability and features, fig. 4, pars. 24-25).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to include a digital camera as an input apparatus as taught by Parulski so that plurality of input devices (e.g. different types of devices) can obtain the capabilities of printer allowing the users/operators of input devices to print images from plurality of different devices (e.g. digital camera, host computer).

Therefore, it would have been obvious to combine Bigi with Parulski to obtain the invention as specified in claim 1.

Response to Arguments

Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to THIERRY L. PHAM whose telephone number is (571)272-7439. The examiner can normally be reached on M-F (9:30 AM - 6:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (571)272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Thierry L Pham/

Examiner of Art Unit 2625

/Edward L. Coles/

Supervisory Patent Examiner, Art Unit 2625